

**REMARKS**

Claims 1-8 are all the claims pending in the application. Applicants thank the Examiner for indicating that claims 3 and 6-8 would be allowable if rewritten to overcome the section 112, 2<sup>nd</sup> paragraph rejection and if rewritten in independent form.

**I. Claim Rejections - § 112, first paragraph:**

Claims 1-8 are rejected under 35 U.S.C. § 112, first paragraph. The Examiner asserts that the limitation of “the supple part deforms causing the separator to allow an improperly closed flap to pass by the separator” is not described in the specification in such a way as to enable one of ordinary skill in the art to make the invention.

In response, Applicants respectfully submit that the specification clearly states that “when the closed envelope is **imperfectly** sealed” in conventional devices, the separator jams (page 1, paragraph [00003]). The specification continues on to state the object of the present invention is to provide a separator which overcomes this drawback (page 1, paragraph [00004]), and that this objective is attained by the novel separator that “is formed by a **supple** part” (page 2, paragraph [00005]). According to page 2, paragraph [00006], “[w]ith this particular configuration of the separator, the closed envelopes whose flaps are imperfectly sealed are thus processed without jamming”. Still further, the specification states that the inventive “suppleness of the active part of the separator” overcomes the problematic “imperfectly sealed” envelopes in the prior art which uses a “rigid separation edge”, because “a supple edge, on the contrary, on **deforming** under the action of this half-open flap”, makes it possible for the envelope to escape, and the “**poorly** closed envelope with half-open flap will therefore pass above the separator” (pages 5-6,

paragraph [000022]). Thus, the present invention improves upon the prior art separator with its “active part which is rendered supple” (page 6, paragraph [000023]).

The term “imperfectly” is synonymous with the terms “improperly” and “poorly”, and thus, the specification clearly enables one of ordinary skill in the art that the invention allows an “improperly closed flap to pass by the separator”. Additionally, as to the term “deforms”, this term is commonly understood by those of ordinary skill in the art to be characteristic of a “supple part”, since an “active part which is rendered supple” is clearly bendable, pliant and deformable. Moreover, paragraph [000022], clearly states that the supple edge “on deforming” under the action of the passage of the poorly closed flap, makes it possible for the flap to escape without tearing. “On deforming” is understood to convey that the supple part “deforms”.

In view of the foregoing, claim 1 is enabled by the specification. Applicants respectfully request the Examiner to reconsider and withdraw this rejection under § 112, first paragraph.

## II. Claim Rejections - § 112, second paragraph:

Claims 1-8 are rejected under 35 U.S.C. § 112, second paragraph. The term “improperly closed” is believed to be defined by the specification since the specification repeatedly describes the problem with “poorly closed” envelopes and flaps, and “imperfectly sealed” envelopes and flaps. The term “improperly” is synonymous with “poorly” and “imperfectly”. Applicants amend the specification to clarify the interchangeability of these terms.

In view of the foregoing, Applicants respectfully submit that the claims are definite.

## III. Claim Rejections – Prior Art:

Claims 1, 2, and 5 are rejected under 35 U.S.C. § 102(b) as being anticipated by or, in the alternative, under 35 U.S.C. § 103(a) as obvious over JP 5-32231 to Tetsuya et al.

Claim 4 is rejected under 35 U.S.C. § 103(a) as being unpatentable over JP 5-32231 to Tetsuya et al. in view of either Whitener (5,021,279) or Anderson et al. (5,922,491).

Applicants respectfully request the Examiner to reconsider these prior art rejections.

Claim 1 is patentable at least by virtue of the recitation of: (1) a separator for separating **folded** envelope flaps from envelope bodies, and (2) where the supply part deforms causing the separator to allow an **improperly closed flap to pass by** the separator.

Tetsuya is directed to open envelopes, and thus, the flaps are not folded. This is evidenced by the fact that Tetsuya is specifically directed to a device in which a mylar opening member 61 is slid inside the envelope opening to allow insertion of items into an already unfolded envelope. The configuration of Tetsuya, in which the rollers and opening member are physically arranged, avails itself only to maintaining an open position of an unfolded flap. There is no teaching, suggestion, or motivation of how the mylar 61 could be modified to operate in the manner of the claimed invention. Since Tetsuya is not capable, either explicitly or implicitly, of separating folded envelope flaps from envelope bodies, nor is there any teaching, suggestion or motivation for modifying it to do so, this feature of **separating folded envelope flaps** from envelope bodies is lost with the Tetsuya reference.

Additionally, Tetsuya is silent with respect to improperly closed flaps. Since Tetsuya is only concerned with envelopes being fed in an open condition, i.e., the flaps are open and not closed, there is no teaching or suggestion, explicitly or implicitly, that the device deforms to cause the separator to allow an **improperly closed flap to pass by the separator**.

In view of the foregoing, Applicants respectfully request the Examiner to reconsider and withdraw the prior art rejection of claim 1.

The remaining rejections are directed to the dependent claims. These claims are patentable for at least the same reasons as claim 1, by virtue of their dependency therefrom.

### Conclusion

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,

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